

b.) Remarks

Claim 1 has been amended in order to recite the present invention with the specificity required by statute. Additionally, claims 2, 12, 13 and 73 are cancelled, all pending claims are amended to maintain their dependency and new claims 74-79 are presented in order to more specifically recite various preferred embodiments of the present invention. The subject matter of the amendment to claim 1 is set forth in original claim 6. The new claims mirror pending claims 22-24. Accordingly, no new matter has been added. Moreover, Applicants respectfully submit that no amendment requires either further consideration or search.

With regards to the previous election/restrictions, the Examiner states that claims 22, 56 and 57 (Office Action Summary, item 4(a)) and claims 21, 56 and 57 (page 2, line 12) are withdrawn. As understood, claims 22, 56 and 57 were intended but the bases for this are unclear; each of claims 21, 22, 56 and 57 further limits the subject matter of an examined claim. Clarification, and rejoinder upon allowance of an antecedent examined claim, are respectfully requested.

Claims 12-15, 18-20, 23, 24, 26, 27, 72 and 73 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not adequately described in the specification as filed. In support of the rejection, the Examiner states (i) there is no specific description of the absence of retinoic acid, (ii) the description regarding BMP4 for epidermal differentiation is unclear and (iii) there is no specific description for the individual combination of elements claimed. As to point (i), such is explicitly taught in original claim 25 as well as at specification page 21, lines 7-9. Regarding point (ii), Applicants respectfully wish to explain that use of BMP4 is simply optional. If there is

some specific concern regarding the language utilized in the specification, Applicants will address it upon clarification by the Examiner. As to point (iii), Applicants are respectfully unaware of any basis in the law for the Examiner's requirement. In fact, regarding that concern, the law is settled that

“[f]irst paragraph of 35 U.S.C. §112 does not require a specific example of everything...where court is dealing only with a possible alternative embodiment within scope of claims, claims cannot be limited to specific examples.” *In re Anderson*, 176 USPQ 331 (CCPA 1973).

Claims 1, 2, 12-15, 18-21, 23, 24, 26-27, 72 and 73 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. In this regard, the Examiner states the effect of BMP4 depends both on the type of stromal cell used and the timing of addition to BMP4 to culture. According to the Examiner, the state of the art recognizes that the effect of these factors is unclear.

At the outset, in effort to reduce the issues, Applicants have above deleted “a stroma cell-derived factor” from claim 1. In this regard, as the Examiner is well aware, in the present specification, examples of the ectodermal cell include a nervous system cell and an epidermal system, and examples of the nervous system cell include a neural stem cell, a nerve cell, a cell of neural tube and a cell of neural crest.

Among these various nervous cells, regarding the preparation of cells of neural tube and cells of neural crest, once differentiation of the embryonic stem cell into a neuroectoderm is started, culturing using a medium containing BMP4 may be carried out continuously (see specification page 41, lines 26-35). On the other hand, for differentiating the embryonic stem cell into the neural stem cell or the nerve cell, it is


neither necessary nor prohibited to add BMP4. Accordingly, claim 1, directed toward differentiating embryonic stem cells into the neural stem cell or the nerve cell, can be carried out without considering the affect of BMP4.

In view of the above amendments and remarks, Applicants submit that all of the Examiner's concerns are now overcome and the claims are now in allowable condition. Accordingly, reconsideration and allowance of this application is earnestly solicited.

Claims 1, 14, 15, 18-24, 26, 27, 56, 57, 72 and 74-79 are presented for continued prosecution.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,


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